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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,412	12/03/2001	Eric W. Triplett	960296.97257	9401

7590

05/28/2003

David M. Kettner
Quarles & Brady LLP
1 South Pinckney Street
P O Box 2113
Madison, WI 53701-2113

EXAMINER

MARX, IRENE

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 05/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,412

Applicant(s)

TRIPLETT ET AL.

Examiner

Irene Marx

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 2-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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The application should be reviewed for errors. Error occurs, for example in the designation of "PA15" for *Gluconobacter diazotrophicus* ATCC 49037. The correct designation appears to be PAI 5. See, e.g., Gillis, M. et al. "Acetobacter diazotrophicus sp. Nov., a Nitrogen-Fixing Acetic Acid Bacterium". International Journal of Systematic Bacteriology 39, pp. 361-364, (1989).

Applicant's election with traverse of the species *Gluconobacter diazotrophicus* PA15, ATCC 49037, within Group I, which comprises claims 1-5 and 14, in Paper No. 5 is acknowledged. The traversal is only with respect to the election of species and is on the ground(s) that the Examiner did not set forth a *prima facie* case of burden because no evidence or reasons or examples were submitted to support a showing of serious burden to justify the restriction.

In response, it is noted that regarding the question of burden of search, classification of subject matter is merely one indication of the burdensome nature of the search involved. The literature search, particularly relevant in this art, is not co-extensive for the various genera/species of bacteria that are claim designated and is much more important in evaluating the burden of search. Burden in examining materially different bacteria belonging to different and distinct species and having materially different morphological and physiological properties also exists.

Clearly different searches and issues are involved with each group.

For these reasons, the restriction requirement is deemed proper and is adhered to. The restriction requirement is hereby made FINAL.

Claim 1 will be examined to the extent that it pertains to *Gluconobacter diazotrophicus* PA15, ATCC 49037. Claims 2-5 and 14 are not directed to this strain and are withdrawn from consideration. Thus, ~~y~~claims 2-17 are withdrawn from consideration as directed to a non-elected invention.

In response to Applicant's query, it is noted that upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kirchhof *et al.*

The claims are directed to an inoculum of *Gluconobacter diazotrophicus* PA15 ATCC 49037.

The reference discloses an inoculum of *Gluconobacter diazotrophicus* PAL 5 ATCC 49037. See, e.g., page 15, col. 2.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sevilla *et al.*

The claims are directed to an inoculum of *Gluconobacter diazotrophicus* PA15 ATCC 49037.

The reference discloses an inoculum of *Gluconobacter diazotrophicus* PAI 5 ATCC 49037. See, e.g., page 184, paragraph 2.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bastian *et al.*

The claims are directed to an inoculum of *Gluconobacter diazotrophicus* PA15 ATCC 49037.

The reference discloses an inoculum of *Gluconobacter diazotrophicus* PAL 5 ATCC 49037. See, e.g., page 15, col. 2.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (703) 308-2922. The examiner can normally be reached on Monday through Friday from 6:30 AM to 3:00 PM.

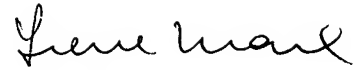
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The appropriate fax phone number for the organization where this application or proceeding is assigned is before final (703) 872-9306 and after final, (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service whose telephone number is (703) 308-0198 or the receptionist whose telephone number is (703) 308-1235.

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A handwritten signature in cursive script, appearing to read "Irene Marx".

Irene Marx
Primary Examiner
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